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10/047,941	01/15/2002	Hai-Quan Mao	GPT-005.03 (22140-503)	5592
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FOLEY HOAG LLP PATENT GROUP, WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02110-2600			EXAMINER SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER
			1714	

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040325

Application Number: 10/047,941
Filing Date: January 15, 2002
Appellant(s): MAO ET AL.

Theresa C. Kavanaugh
For Appellant

MAILED

MAR 31 2004

GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/13/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 134-154 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 134-154 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not have a "Q", which can be O or NR', where R' is H or alkyl. As a matter of fact there is no "Q" mentioned in the entire specification. In said specification the double bonds are always connected to oxygen. Furthermore, there is no mention of "L" being any non-interfering substituent, branch or straight chain aliphatic group of any undetermined length, a divalent aryl group or a polymeric group. "L" has to be a divalent branched or straight chain aliphatic group having 1-20 carbon atoms, which can be an alkylene group, an alkylene group substituted with a non-interfering substituent, for example, hydroxy-, halogen- or nitrogen substituted alkylene, or an alkenylene group. See from page 9, line 10, to page 10, line 17.

Claims 134-154 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for oxygen atoms being connected by double bonds to carbon atoms and "L" being a divalent branched or straight chain aliphatic group

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having 1-20 carbon atoms, so long as it does not interfere with the polymerization or biodegradation of the polymer, which aliphatic group can be alkylene, alkylene substituted with a non-interfering substituent or alkenylene, does not reasonably provide enablement for NR' being connected by double bonds to carbon atoms when R' is H or alkyl, or for "L" being just any kind of non-interfering substituent, branched or straight chain aliphatic group of undetermined length, a divalent aryl group or a polymeric group. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. See from page 9, line 10, to page 10, line 17.

(11) Response to Argument

"L" is not recited on page 10, lines 1-17 as a branched or straight chain aliphatic group of any length, a divalent aryl group, a polymeric group or any kind of non-interfering substituent. The phrase on page 9 last line and page 10, line 1, stating "L can be any divalent branched or straight chain aliphatic group having 1-20 carbon atoms" controls. The rest is a subset. As far as "Q" is concerned, the examiner has been unable find any description or anything but oxygen atoms being connected to carbon atoms by double bonds. See Examples 1 and 3. Similarly, the examiner has been unable to find any aromatic, polymeric or generally non-interfering unspecified linking groups in the Examples. Since the only polymers shown in the Examples are poly (L-lactide-co-ethyl phosphate) and poly (L-lactide-co-hexyl phosphate) it is apparent that the "L"-s used are 2 and 6 carbon straight chain aliphatic groups, namely alkylene groups. The examiner requested applicants to point out the page and line in

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the specification where "Q" is defined, but applicants only pointed to pages 38-45. That is not exactly specific information. The instant claims are not part of the original specification since claims 134 to 154 were not present in the grandparent application, 09/053,649, now U.S. Patent 6,166,173. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

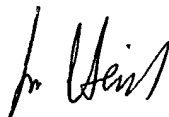
Peter Szekely
Primary Examiner
Art Unit 1714



P.S.
March 25, 2004

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